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OFFICE OF PETITIONS

In re
O'Connell, et al.
Application No. 09/954,677 : DECISION ON APPLICATION
Filed: September 15, 2001 : FOR PATENT TERM ADJUSTMENT
Patent No. 6,957,908 :
Issued: October 25, 2005 :
Attorney Docket No. 061300-0242

This letter is in response to the "REQUEST FOR RECONSIDERATION OF APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)", filed September 28, 2005. Applicants request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to six hundred forty-three (643) days.

The application for patent term adjustment is DISMISSED.

On March 30, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment

(PTA) to date is zero (0) days. On June 24, 2005, Applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is six hundred forty-three (643) days.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of six hundred forty-three (643) days, pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), reduced by eight hundred thirty-five (835) days of Applicant delay pursuant to 37 C.F.R. § 1.704(c)(3).

A Notice to File Missing Parts was mailed on October 16, 2001. Applicants failed to timely reply. Accordingly, the application became abandoned on December 17, 2001. A petition to revive was first filed on January 9, 2004, and was finally granted in a decision mailed on April 30, 2004.

In their application for patent term adjustment filed June 24, 2005, Applicants stated that the Office mailed a Withdrawal of Previously Sent Notice on July 29, 2004, indicating that the Notice of Abandonment mailed on November 10, 2003 was mailed in error. However, the application for patent term adjustment was dismissed in a decision mailed on September 1, 2005. The decision pointed out that a review of the application file failed to reveal the presence of a Withdrawal of Previously Sent Notice.

On renewed petition, applicants have supplied the Office with a copy of the July 29, 2004 Withdrawal of Previously Sent Notice. However, a further review of the record reveals that the Withdrawal of Previously Sent Notice was in fact mailed in error. The application was properly abandoned on December 17, 2001. The Notice to File Missing Parts mailed October 16, 2001 was properly mailed to the address of record (James A. Wilke, Foley & Lardner, Firststar Center, 777 East Wisconsin Avenue, Milwaukee, WI 53202-5367). A copy of the Notice is enclosed for petitioner's records.

Rather than file a petition to withdraw the holding of abandonment due to non-receipt of the Notice to File Missing Parts, applicants filed a petition to revive the application

¹ Applicant filed the application for patent term adjustment on the same date as the issue fee.

under 37 C.F.R. § 1.137(b) on January 9, 2004.² The petition was granted in a decision mailed on April 30, 2004. The decision revived the application under 37 C.F.R. § 1.137(b); it did not *sua sponte* withdraw the holding of abandonment.

37 C.F.R. § 1.704(c)(3) states:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) **The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or**

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed; (emphasis added)

Therefore, Applicant should have been assessed delay for the period from December 17, 2001 (the date the application became abandoned) to April 30, 2004 (the date of mailing of the decision reviving the application), or 865 days, not 835 days.

In view thereof, the correct determination of patent term adjustment is **zero (0) days** (643 days of PTO delay, reduced by 865 days of applicant delay).

² A petition to revive an abandoned application should not be confused with a petition to withdraw the holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, controlling dates, or applicant contends he did not receive an Office action), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g. the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 is necessary to revive the abandoned application.

Telephone inquiries specific to this letter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery A. Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enc: October 16, 2001 Notice to File Missing Parts (1 page)